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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,272	01/02/2001	Thomas W. Astle	130-132	9126

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EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

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DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/752,272

Applicant(s)
Astle

Examiner
Ivars Cintins

Art Unit
1724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 21, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are again rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are again deemed to be incomplete because they fail to recite sufficient structure to perform the recited functions. As pointed out in the previous Office Action, the claims recite an "eluter instrument" but fail to positively recite sufficient structure for performing this function. It appears essential that the device include some type of structural elements (e.g. tubes 470 and 180) for contacting an eluent with the SPE medium in the device. Similarly, it appears essential that the recited device include some mechanism for introducing and removing the SPE medium from the treatment area in the device. Also, claim 1 is indefinite because it recites an apparatus for moving the upper seal, in both elements (b) and (c) of this claim. Applicant is advised that an amendment changing "upper" to "lower" in element (c) of claim 1 would overcome this portion of the rejection. Similarly, the term "said seals" (claim 9, line 7) is indefinite as to which seals are intended.

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Applicant is advised that an amendment inserting "upper" before "seals" in line 4 of claim 9, and inserting "lower" before "seals" in line 7 of claim 9 would overcome this portion of the rejection. Also, the last three lines of claim 1 are functional and indefinite because sufficient structure has not been recited for performing the recited function of eluting compounds of interest "sequentially from said plurality of areas to another, single instrument." Applicant is advised that an amendment to claim 1 positively reciting structural elements which are capable of performing this recited function would overcome this portion of the rejection.

Applicant's arguments filed January 21, 2003 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that no structure for introducing or removing the eluant from the instrument is included because that is not part of the eluter instrument. This argument is not understood. Figure 8 of the drawings clearly shows an inlet tube **470** for introducing an eluting liquid (e.g. solvent) into the SPE medium; and an outlet tube **180** for removing eluent and compounds of interest from the device. Furthermore, it is not clear that the recited device could function as "an

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eluter instrument" without these apparently essential structural components.

Similarly, Applicant argues that there is no structure for introducing or removing an SPE medium from the instrument, since those steps can be performed manually. Again, this argument has been noted and carefully considered, but is not deemed to be persuasive of patentability. It appears essential that some type of transfer mechanism be present in order to move the SPE medium into and out of contact with the elution area. Applicant has disclosed stacker assemblies 162 and 164 in combination with shuttle 300 for performing this function (see Figs. 3, 5 and 6), and it is not clear that such a function could be performed manually in the recited device.

Claims 1-10 would be allowed if rewritten or amended to overcome the above rejection under 35 U.S.C. § 112.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Ivars Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
April 6, 2003